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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,479	08/07/2003	Alejandro Wiechers	200207440-1	1075

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INTELLECTUAL PROPERTY ADMINISTRATION  
FORT COLLINS, CO 80527-2400

EXAMINER
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MILIA, MARK R

ART UNIT	PAPER NUMBER
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2625

MAIL DATE	DELIVERY MODE
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06/13/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/635,479

Applicant(s)

WIECHERS, ALEJANDRO

Examiner

Mark R. Milia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Double Patenting***

1. Claims 1-10 of this application conflict with claim 1-10 of Application No. 10/630878. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 5-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 5-8 are drawn to functional descriptive material NOT claimed as residing on a computer readable medium.

Claims 5-8, while defining a program product, do not define a "computer-readable medium" and is thus non-statutory for that reasons. A program product can range from paper on which the program is written, to a program simply contemplated

and memorized by a person. The examiner suggests amending the claim to embody a "computer-readable medium" for storing the program in order to make the claim statutory.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 4-6, and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0078160 to Kemp et al.

Regarding claims 1, 5, and 9, Kemp discloses a method, program, and system of managing workflow in a commercial printing environment including a designer location and a print service provider location, said method comprising: establishing a closed-loop communication link between the designer location and the print service provider location (see Figs. 1 and 3 and paragraph 35 lines 1-6), creating a press ready file at the designer location using updated device configuration information received from the print service provider location via said closed-loop communication link (see Figs. 3 and 4 and paragraphs 36, 43, 48, 52-58, 60-62, 69, and 84-87, reference shows that portal 3 contains capabilities associated with the printers located at the service provider and that print driver 282 communicates with the portal 3 and renders the print job into a format

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suitable for printing based on such communication), submitting said press ready file to the print service provider location via said closed-loop communication link (see Figs. 4 and 10 and paragraphs 52-58 and 84-87) and receiving a printed output of said press ready file and packaging said printed output using an automated packaging device (see paragraphs 40-41 and 64, reference states that the necessary equipment to finish a print job would be included at the service provider and a user can select the type of delivery of the printed and finished materials).

Regarding claim 10, Kemp discloses an automated packaging device for use with a design-to-press workflow in a commercial printing environment including a designer location, a print service provider location and a closed-loop communication link between them, said automated packaging device comprising: a memory for storing device information (see Figs. 1, 3, and 4 3 and paragraphs 40-43) and a communication module for connecting to said closed-loop communication link to communicate device information with the designer location and the print service provider location (see Figs. 1, 3, and 4 3 and paragraphs 40-43, 52-58, and 84-87).

Regarding claim 2, Kemp further discloses wherein said automated packaging device is a Design to Ship enabled device and forms part of said closed-loop communication link (see Fig. 9 and paragraphs 41 and 64).

Regarding claims 4 and 8, Kemp further discloses, wherein after said step of submitting, said method further comprises a step of verifying, at said print service provider location, that said press ready file will be produced at said print service

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provider location as designed at the designer location and, if not, correcting said press ready file to ensure production substantially as designed (see paragraphs 84-87).

Regarding claim 6, Kemp further discloses wherein said automated packaging device is a Design to Pack enabled device and forms part of said closed-loop communication link (see Fig. 9 and paragraphs 41 and 64).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kemp.

Kemp does not disclose expressly wherein said automated packaging device is assigned a unique identifier.

However, it is well known in the art for printers, finishing/packaging devices to have unique identifiers, such as IP addresses, URLs, MAC addresses, etc. to allow the device to be identified and allow data to be easily transferred to and from the device.

Therefore, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to assign a unique identifier to the automated packaging device

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of Kemp because it would allow the device to be easily and accurately identified and also allow data to be easily and accurately transferred to the device.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. To further show the state of the art please refer to the attached Notice of References Cited.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

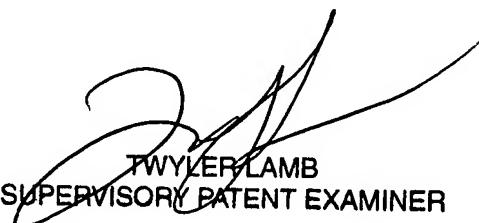
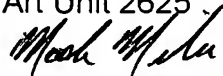
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Lamb can be reached at (571) 272-7406. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MRM

Mark R. Milia  
Examiner  
Art Unit 2625



TWYLER LAMB  
SUPERVISORY PATENT EXAMINER